No. 9327

In the United States Circuit Court of Appeals

For the Ninth Circuit.

PAYNE FURNACE & SUPPLY COMPANY, INC., a corporation,

Appellant,

vs.

WILLIAMS-WALLACE COMPANY, a corporation,

Appellee.

APPELLANT'S BRIEF.

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APPELLANT'S BRIEF.

Appellant, Payne Furnace & Supply Company, Inc., appeals from an interlocutory decree of the District Court for the Northern District of California granting an injunction prohibiting appellant's manufacture, use or sale of composite pipe embodying the alleged invention of patent 2,013,193.

Jurisdiction.

No question of jurisdiction or pleading is involved. The suit arises under the patent laws, of which the District Court has exclusive original jurisdiction. The appealed decree was filed June 13, 1939 [I. 65].* The notice of appeal was filed July 12, 1939, within thirty days (*Judicial Code,* Sec. 129).

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*Herein the Roman numeral refers to the volume of the Record and is followed by the page number.

Statement of the Case.

Appellee, Williams-Wallace Company, filed its complaint alleging invention by Jacob A. Stadtfeld "of certain new and useful improvements in Composite Pipe Construction"; the grant of the patent in suit No. 2,013,193 therefor; the purported assignment thereof to plaintiff-appellee; and the alleged infringement thereof by appellant's predecessor in business,—Payne Furnace & Supply Company [I. 1-6]. By supplemental bill of complaint, appellant was made a joint defendant with its predecessor [I. 21-23]. Appellant answered and filed a counterclaim [I. 23-29].* The answer denied that Stadtfeld made any invention [Par. IV – I. 24-25] and affirmatively alleged want of invention [Par. XIII. – I. 33] and anticipation [Pars. X., XI. – I. 29-31] and public use by sundry parties [Par. XII. – I. 31-33]. The answer further alleged plaintiff is estopped to maintain this suit for the reason that this defendant has a license and shop-right to make, use and sell vent pipe like that shown and described in the patent in suit, based upon facts and circumstances alleged therein [Par. XX. – I. 36-39]. What became of the original defendant, Payne Furnace & Supply Company, is not disclosed by the record and is immaterial here. The appealed decree refers to and is against appellant, Payne Furnace & Supply Company, Inc. The District Court's findings of fact [I. 46-62] name only appellant,—Payne Furnace & Supply Company, Inc.

As granted the patent in suit contained three claims [III. 638]. These claims, (which are the operative part of

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*Although this answer purported to be in the name of and by appellant's predecessor, Payne Furnace & Supply Company, by stipulation [I. 44] it was "adopted also as the answer of defendant Payne Furnace & Supply Company, Inc."

the letters patent – R. S. U. S. 4888, 35 USCA, Sec. 33;* *Motion Picture Patents Co. v. Universal Film M. Co.,* 243 U. S. 502; *Henry v. Los Angeles,* 255 F. 769, 780 (C.C.A. 9); *Altoona Publix Theatres, Inc. v. American Tri-Ergon,* 294 U. S. 477, 487) are addressed to and comprehend "a composite pipe construction." As we shall hereinafter specifically point out, such a composite pipe construction was old and well known,—no invention was required in 1932 to produce it. However, this is fully admitted by a so-called "disclaimer" filed by appellee [III. 638] after the commencement of this suit and nine months after the case was at issue [I. 40]. It is admitted by this disclaimer that the three claims of the patent are invalid. In an attempt to overcome this invalidity and to revitalize the patent, appellee filed this so-called disclaimer purportedly under *R. S. U. S. 4917 and 4922* (35 USCA, Secs. 65, 71).** This disclaimer statute does not authorize the Commissioner of Patents to consider or adjudge in any manner or degree the legality or the legal effect of a disclaimer. His authority is purely ministerial, *i. e.,* limited to making a record of the purported disclaimer when he has determined that it has been properly executed by the then owner or owners of the patent as shown by the title books of the Patent Office; whereas the Commissioner of Patents has complete authority over an application for an amended or reissued patent and may refuse and reject the new claims for lack of patentable novelty, lack of invention, anticipation, etc. The disclaimer statute (*R. S. U. S. 4917 and 4922*) provides merely for an excision from the patent of a material or substantial part

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*See Appendix.

**See Appendix.

of the thing patented, *i. e.,* that which the inventor has claimed which is more than his invention. It does not authorize the introduction thereby into the patent of a claim to import subject-matter substantially different from that comprehended by the granted claim or claims, nor the predicating of patentable novelty upon a feature of construction or the use of a mechanical element omitted from the claim as granted by the Patent Office. The latter may be accomplished only by due formal application (accompanied by payment of the fees required by law) for an amendment or reissued patent, which application is subject to full re-examination, rejection, etc. by the Commissioner of Patents as before stated (*R. S. U. S. 4916; 35 USCA, Sec. 64*).* The disclaimer statute "expressly limits a disclaimer to a rejection of something before claimed as new" (*Union Metallic Cartridge Co. v. U. S. Cartridge Co.,* 112 U. S. 624, 28 L. ed. 828; "* * * certainly it cannot be used to change the character of the invention" (*Hailes v. Albany Stove Co.,* 123 U. S. 582, 31 L. ed. 284, 286).

This appeal therefore raises the question of law: Is the so-called disclaimer within the statutory right and obligation, or is it an unlawful attempt to obtain an amended or reissued patent while avoiding the scrutiny of the Patent Office and the latter's examination and determination of the patentable novelty, etc., of the new claims formulated by such disclaimer? (Cf., for example, *Fischer v. Automobile Supply Mfg. Co.,* 201 F. 543; affirmed 209 F. 225—C. C. A. 2.)

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*See Appendix.

The patent as granted contained three claims, each of which was for "A composite pipe construction". Such composite pipe is defined (claims 1 and 2) as "comprising an outer tube * * * and an inner tube slidably located inside the insulating material", the third element being one or more layers of insulating material located between the inner and outer tubes. Claim 3 was substantially the same as claims 1 and 2, differing therefrom only in that it uses the term "telescopically" with respect to the location of the inner tube within the outer tube and inside the insulating material. The alleged invention so defined is in no manner dependent upon or concerned with such composite pipe being made in sections, or each section being provided with alleged newly invented means for connecting sections together to secure a new result due to such novel connecting means. This fact is emphasized by consideration of the negotiations for the patent in the Patent Office, in which proceedings a claim was presented upon a specific means for connecting sections together. This was claim 8 submitted by amendment [III. 698], thrice rejected as anticipated and embodying no invention [III. 701, 705, 709], and withdrawn or cancelled [III. 709]. This rejected and cancelled claim 8 defined the invention as "comprising a plurality of composite pipe sections", defining each section as including an inner and an outer pipe, "the outer pipe having a female fitting at its lower end and a male fitting at its upper end", and "the inner pipe having a male fitting at its lower end and a female fitting at its upper end", and defining the formation thereby of moisture-proof joints, etc. Thus the Patent Office ruled, and the inventor acquiesced in and accepted the ruling, that the provision of the male and female fittings at the ends of the pipe sections was old,

well-known and anticipated. Comparing the granted claims 1, 2 and 3 of the patent with this rejected claim 8, the difference in subject-matter is made clear. In the claims of the patent Stadtfeld has "particularly point(ed) out and distinctly claim" (ed) "the part, improvement, or combination which he claims as his invention or discovery" (*R. S. U. S. 4888; 35 USCA, Sec. 33*)* as residing in the composite pipe construction of inner and outer tubes with insulating material between them, the inner pipe slidably located within the outer pipe. This definition does not comprehend nor depend upon the existence of a plurality of such composite pipes, much less upon any novel invention in the means or method of connecting together two or more of such composite pipes. The disclaimer admits that a composite pipe construction of such inner and outer pipes with insulating material between them, the inner pipe slidably located within the outer pipe, was not Stadtfeld's invention; that in so claiming in claims 1, 2 and 3 the alleged invention he had "claimed more than that of which he was the original or first inventor or discoverer". The patent claims are for a "combination" of the three elements specified, of inner and outer pipes and the insulating material therebetween. The disclaimer attempts to change the character of the combination claimed to include sectional pipes and include the male and female fittings at the ends for connecting the sectional pipes together. The disclaimer in effect admits that thereby a different combination is called for.

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*See Appendix.

The District Court did not adjudge any one of these three patent claims valid. No such issue was presented to it for adjudication. The District Court adjudged only the claims as they are restated by the disclaimer. The District Court found:– "The claims of the patent in suit were narrowed in scope by qualifying disclaimers", etc. [finding 7 – I. 51]. Such finding, as well as findings 8, 9 and 10 are not findings of fact adjudged upon oral or conflicting evidence. On the contrary, such findings are based solely upon documentary evidence and are conclusions of law respecting the legal effect of indisputable and incontestable documentary evidential facts. They are therefore subject to full review by this Court.

It is appellant's position that instead of the purported disclaimer narrowing in scope the patent claims, the disclaimer attempts (1) to make additional structural elements parts of the combinations of the patent claims and (2) to change the character of the claims from a composite pipe construction to a sectional pipe construction and including a plurality of sections within each claim; that thereby an attempt has been made to secure a reissued or amended patent with different claims, in avoidance of the requirements of the Statute that a patent may only be reissued with new claims upon an application accompanied by the payment of the government fees, as provided for in *R. S. U. S. 4916 (35 USCA, Sec. 64)*.

The case also presents the issue:– Even if, disregarding the plain provisions of the disclaimer statute and of the

reissue statute, it can be assumed that the government ever granted such a patent containing such three claims as re-formed and re-stated by the attempted disclaimer,—does the so-called combination particularly pointed out and claimed thereby disclose patentable invention or discovery? Does the addition to a section of such admittedly old and well known composite pipe of the admittedly old, well known male and female fittings therefor rise to the dignity of invention and possess patentable novelty? Or is it within the rule applied by this Court in *Ray v. Bunting Iron Works,* 4 F. 2nd 214, that there is no invention in merely selecting and assembling the most desirable parts of different old, well known mechanisms in the same art, where each operates in the same way in the new device as it did in the old, and effects the same results?

The case further involves the question of whether appellant has not the right to manufacture, use and sell the sectional pipe. Appellant was induced by the inventor Stadtfeld, long prior to even the filing of an application for patent by him, to enter upon the manufacture, sale and use of the alleged infringing pipe and to invest its money in equipment, materials, advertising, etc., whereby a business was at appellant's expense created and whereby a demand for the product was created. The case presents, therefore, the question or issue,—Have not the alleged infringing acts been performed by appellant with the consent and allowance of the inventor, and has not appellant proceeded as a matter of right and has not appellant a right

to continue to manufacture, use and sell the sectional composite pipe, *even if a valid patent exists thereon?*

Stadtfeld came to appellant, solicited and induced appellant to, and entered appellant's employ for the very purpose of appellant's making, using and selling this sectional composite pipe and building up a business therein. He was employed upon a salary. Suddenly, without notice to appellant, he decamped. He left Beverly Hills, California, where appellant's business was located, and next appeared in San Francisco and interested appellee in manufacturing this pipe. He then filed the application for patent thereon. Did Stadtfeld breach his agreement with appellant? If so, can he (or can his successor-in-interest, appellee, which was fully put upon notice of Stadtfeld's and appellant's relations in manufacturing and selling pipe and of appellant's investment therein and had full knowledge of Stadtfeld's breach of his agreement with appellant) have any standing in a court of equity to enforce a subsequently granted patent and prohibit the continuation of the manufacture, use and sale of such pipe, and to require appellant to pay profits or damages arising out of such manufacture, use or sale by appellant? This question involves both oral testimony and documentary proofs. Largely, the relations between appellant and Stadtfeld, the knowledge of appellee thereof, etc., is documentary. This also involves the question of asserted assignment and sale of the invention to one Dutton. The facts and evidence are too lengthy for statement here and will be considered when considering this defense.

Questions Involved.

(1) By filing the so-called disclaimer of February 25, 1938 [III. 638] appellee has disclaimed claims 1, 2 and 3 of the patent in suit as granted by the Patent Office. Is this such a disclaimer as is authorized by statute, or does such disclaimer render the whole patent invalid because in effect it attempts to thereby secure a new patent for a new and different combination of elements from the combination or combinations called for by said claims 1, 2 and 3 of the patent as granted?

(2) Is the patent invalid because by said purported disclaimer appellee has attempted to assert patentable invention in the subject-matter of claims of invention made in the application for said letters patent, rejected by the Patent Office and cancelled by the applicant, (for example, rejected and abandoned claim 8 presented during the prosecution of the application for said patent), which appellee is estopped to assert?

(3) Is the patent void because appellee unreasonably neglected and delayed in filing said disclaimer?

(4) Is the District Court's holding, predicated upon findings Nos. 7-16, inclusive, that said patent as to claims 1, 2 and 3 as modified by said purported disclaimer is good and valid in law, in error in that said findings are contrary to the evidence and proofs herein?

(5) If said purported disclaimer can be sustained under the disclaimer statute, are said claims 1, 2 and 3 as so modified thereby void for want of invention and anticipation?

(6) Did the District Court err in failing to find that Jacob A. Stadtfeld did not make the invention of the

patent in suit until on or about May, 1933, as shown by the correspondence between said inventor and appellant, in evidence under the group of letters, Plaintiff's Exhibit 10? Are the District Court's findings Nos. 24 and 25 therefore in error and contrary to the evidence and proofs?

The Stadtfeld Patent.

An inventor, to secure a valid patent, must comply with R. S. U. S. 4888 (35 USCA, Sec. 33) which provides that before any inventor shall receive a patent for his invention he shall make application therefor "and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery." Two things are required of the inventor: *1st,* that he shall explain the principle of the machine, and, *2nd,* that he shall particularly point out and distinctly claim the part, improvement or combination which constitutes his invention. A patent is a contract (*National Hollow B. B. Co. v. Interchangeable B. B. Co.,* 106 F. 693; *O'Brien-Worthen Co. v. Stempel,* 209 F. 847, 852.)

What then did Stadtfeld set forth as the principle of his machine? (The alleged invention is classified under R. S. U. S. 4886, 35 USCA, Sec. 31, as a "machine".) What was the agreed definition of Stadtfeld's invention as comprehended by the granted claims? (*Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.,* 294 U. S. 477, 487, 79 L. ed. 1005, 1012; *Corn Products Ref. Co. v. Penick & Ford,* 63 F. (2d) 26, 31.) The patent [III. 637] states:

"This invention relates to improvements in composite pipe constructions of the kind used in conveying gases or fluids." [*Id.* col. 1, ll. 1-3] and states an object of the invention "is to provide an improved composite pipe construction consisting of an inner core pipe of non-corrosive material, an outer metallic pipe or casing spaced from the inner core pipe, and an intermediate filler of air cell heat insulating material interposed between the inner and outer pipes." [*Id.* ll. 4-10.] The claims as granted comprehend only the construction expressly set forth in this last quoted paragraph, to-wit: "A composite pipe construction comprising an outer tube, one or more layers of insulating material located around the inside surface of the said tube, and an inner tube slidably located inside the insulating material." [Claim 1 – III. 638.] Claim 3 differs from claim 1 in that the two pipes are said to be "telescopically arranged with respect to one another" instead of "slidably". Claim 2 specifies these same three elements,—the inner and the outer pipes and the insulating material therebetween,—in slightly more restricted language.

In the third paragraph of the patent [III. 637, col. 1, ll. 16-26), the patent states that the object of the invention is to provide an improved composite pipe construction, of the type characterized in the preceding paragraphs, and "having end fittings which provide leak proof joints at the joined ends of a number of sections," etc. No reference whatever is made in either of the claims as granted to such leak proof joints or to any mechanical means for forming or providing such joints. These are not elements of the combination called for by any one of the claims as granted. It is important, however, to note that

the application for the Stadtfeld patent as originally filed contained three claims addressed to and comprehending the means for providing such leak proof joints. These are claims 3, 4 and 5 of the application as filed [III. 694]. These claims were rejected upon reference to prior patents [696] and cancelled by the first amendment [698]. A further claim 8 calling for, in even more detail, the mechanical combination as including the pipe sections and the male and female fittings at the respective ends of the pipe sections was presented [698]. This claim likewise was rejected by the Patent Office [703] as anticipated and disclosing no invention [703, 705] and finally rejected [708] and cancelled and withdrawn [709], Stadtfeld acquiescing in the ruling that there was no patentable novelty or invention in providing the pipe sections with such male and female fittings. Stadtfeld "thus eliminated from his claim those things which were excluded by surrender of scope and of definition of his claimed combination. Wright v. Yuengling, 155 U. S. 47, 15 Sup. Ct. 1, 39 L. Ed. 64; Roemer v. Peddie, 132 U. S. 313, 10 Sup. Ct. 98, 33 L. Ed. 382; Greene v. Buckley, 135 Fed. 520, 68 C. C. A. 70." (*Wilson & Willard Mfg. Co. v. Union Tool Co.*, 249 F. 729, 735 – C. C. A. 9.)

We thus see that it was not an inadvertent or accidental omission, but a deliberate, intended action on the part of Stadtfeld to ground the three granted claims of the patent upon the combination of the three elements,—outer and inner tubes and interposed insulating material,—and to omit from the patent franchise any claim directed to the connecting means or fittings for joining together two or more sections of the pipe in such a manner as to provide leak proof joints.

Appellee grounded its purported cause of action against this appellant upon the hypothesis that by manufacturing, using and selling composite pipe consisting of inner and outer tubes with interposed insulating material therebetween, appellant had infringed such patent. After appellant had answered, appellee filed in the United States Patent Office a purported disclaimer. (This is printed at the end of the Stadtfeld patent [III. 638].) The disclaimer statute authorizes, under certain conditions as to inadvertence, accident or mistake, and absence of fraudulent or deceptive intentions, the patentee to "make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent". "The thing patented" is the thing particularly pointed out and distinctly claimed in the claims. "Nothing described in the letters patent is secured thereby, unless it is covered by a claim." (*Deller's Walker on Patents,* Sec. 240, p. 1204; Sec. 256, p. 1231; *Motion Picture Patents Co. v. Universal Film M. Co.,* 243 U. S. 502, 510, 61 L. ed. 871, 876; *McClain v. Ortmayer,* 141 U. S. 419, 424, 35 L. ed. 800, 802; *Henry v. City of Los Angeles,* 255 F. 769, 780 – C. C. A. 9; *Howe Machine Co. v. National Needle Co.,* 134 U. S. 388, 33 L. ed. 963, 967.) The purported disclaimer is not an excision of any part of any claim. It is not an excision from any claim of any part of the thing patented. Conversely, the disclaimer statute does not authorize the patentee to make a mechanical part or element which has been described in the descriptive portion of the patent or shown in the drawings thereof, but not one of the things patented, (whether such mechanical part or element was intentionally or inadvertently omitted from the thing patented,) an essential part of a granted claim. This is not an excision of "a part of the thing patented", but is to

formulate a new claim for a different "combination" comprised of new and additional elements. If it be desired to so secure a new claim, the patentee's remedy is under the reissue statute (R. S. U. S. 4916; 35 USCA, Sec. 64).

R. S. U. S. 4888 (35 USCA, Sec. 33) requires the inventor to particularly point out and distinctly claim the "combination" which he claims as his invention or discovery. A combination in patent law is an entity separate and distinct from its component parts (*Rowell v. Lindsay,* 6 F. 290, 295; *Yesbera v. Hardesty Mfg. Co.,* 166 F. 120, 125 – C. C. A. 6; *Hopkins on Patents,* p. 121; *Robinson on Patents,* Vol. 1, p. 219.) The "combination" (of the three elements, *i. e.,* (1) the outer pipe or tube, (2) the inner pipe or tube, and (3) the interposed layer of insulating material,) is in patent law to be considered and viewed as an entity separate and distinct from its parts. A combination of these same three elements and of an additional element or elements (as, for example, male and female fittings at opposite ends of alternate sections of the composite pipe) is likewise in patent law a distinct entity, a different combination. Obviously this logically must follow from the very purpose of the statutory requirement that the inventor "shall particularly point out and distinctly claim * * * the combination". The Stadtfeld patent identifies the claimed and patented combination by a recital of the respective mechanical elements or devices and their manner of association. This is the means or method or way of identifying the combination. It is a well settled rule that a claim for a combination of elements is not infringed when one of the elements is omitted without supplying an equivalent element. This rule is based upon the fact that a combination of three

elements, A, B & C, is not infringed by a combination of A and B. Let us then consider the three granted claims of this Stadtfeld patent and the three claims as they would exist if the disclaimer was legal and operative.–

The Patent Claims.

CLAIM 1.

A composite pipe construction

comprising

(a) an outer tube,

(b) one or more layers of insulating material located around the inside surface of the said tube, and

(c) an inner tube slidably located inside the insulating material.

The "Disclaimer" Claims.

CLAIM 1.

Composite sectional pipes for conducting fluids or gases of combustion

comprising

(a) an outer tube,

(b) one or more layers of insulating material located around the inside surface of the said tube,

(c) an inner tube slidably located inside the insulating material,

(d) adjacent ends of the inner and outer pipes of each section having male and female ends with the male end of the inner pipe located adjacent the female end of the outer pipe, and with the male end of an inner tube pointing downwardly and adapted to be fitted inside the female end of the adjoining lower section so that any condensates forming inside the said

The Patent Claims.

CLAIM 1.

The "Disclaimer" Claims.

CLAIM 1.

inner pipes are carried over the joint, and with the male end of the outer pipe of a section pointing upwardly and adapted to be located inside the female end of the next higher pipe of another section,

(e) so that a joint is provided which sheds any exterior moisture running downwardly over the outer pipes, and the completed joints between adjacent ends of adjoining sections of the inner and outer pipes are in substantial radial alignment,

(f) and each string of connected pipe, outer and inner, is independently supported and maintained in connected relationship,

(g) and the insulating material interposed between the two pipes provides an intermediate filler and has a plurality of air cells running longitudinally therethrough.

The Patent Claims.

CLAIM 2.

A composite pipe construction

comprising

(a) an outer tube,

(b) a layer of insulating material formed into a tube and positioned inside the outer tube with its outside surface in contact with the inner surface of the outer tube, and

(c) an inner tube slidably positioned inside the tube of insulating material with its outer surface in contact with the inner surface of the said tube of insulating material.

The "Disclaimer" Claims.

CLAIM 2.

Composite sectional pipes for conducting fluids or gases of combustion

comprising

(a) an outer tube,

(b) a layer of insulating material formed into a tube and positioned inside the outer tube with its outside surface in contact with the inner surface of the outer tube.

(c) an inner tube slidably positioned inside the tube of insulating material with its outer surface in contact with the inner surface of the said tube of insulating material,

(d) adjacent ends of the inner and outer pipes of each section having male and female ends with the male end of the inner pipe located adjacent the female end of the outer pipe, and with the male end of an inner tube pointing downwardly and adapted to be fitted inside the female end of the adjoining lower sec-

The Patent Claims.

CLAIM 2.

The "Disclaimer" Claims.

CLAIM 2.

tion so that any condensates forming inside the said inner pipes are carried over the joint, and with the male end of the outer pipe of a section pointing upwardly and adapted to be located inside the female end of the next higher pipe of another section,

(e) so that a joint is provided which sheds any exterior moisture running downwardly over the outer pipes, and the completed joints between adjacent ends of adjoining sections of the inner and outer pipes are in substantial radial alignment,

(f) and each string of connected pipe, outer and inner, is independently supported and maintained in connected relationship,

(g) and the insulating material interposed between the two pipes provides an intermediate filler and has a plurality of air cells running longitudinally therethrough.

The Patent Claims.

CLAIM 3.

A composite pipe construction

comprising

(a) an inner core pipe,

(b) an external pipe spaced from the inner pipe, and

(c) insulating material interposed between the two pipes, the said pipes being telescopically arranged with respect to one another.

The "Disclaimer" Claims.

CLAIM 3.

Composite sectional pipes for conducting fluids or gases of combustion

comprising

(a) an inner core pipe,

(b) an external pipe spaced from the inner pipe,

(c) insulating material interposed between the two pipes, the said pipes being telescopically arranged with respect to one another,

(d) adjacent ends of the inner and outer pipes of each section having male and female ends with the male end of the inner pipe located adjacent the female end of the outer pipe, and with the male end of an inner tube pointing downwardly and adapted to be fitted inside the female end of the adjoining lower section so that any condensates forming inside the said inner pipes are carried over the joint, and with the male end of the outer pipe of a section pointing upwardly and adapted to be located

The Patent Claims.	*The "Disclaimer" Claims.*
CLAIM 3.	CLAIM 3.
	inside the female end of the next higher pipe of another section,
	(e) so that a joint is provided which sheds any exterior moisture running downwardly over the outer pipes, and the completed joints between adjacent ends of adjoining sections of the inner and outer pipes are in substantial radial alignment,
	(f) and each string of connected pipe, outer and inner, is independently supported and maintained in connected relationship,
	(g) and the insulating material interposed between the two pipes provides an intermediate filler.

The foregoing comparison of the patent claims as granted and of the purported disclaimer's re-statement and re-construction of claims makes clear:–

The Patent Claims.– These clearly define as the invention patented a single-length of composite pipe construction comprising three elements only, – (a), (b) and (c). They do not in any manner indicate,—much less "particularly point out and distinctly claim,"—that the invention resides in providing sectional composite pipes,

nor that the invention includes mechanical means,—much less a specific form and interrelation of mechanical means,—for joining the lengths of pipe or sections together, or that such joining or connecting means are of such form or construction as to provide leak proof joints between the adjoining sections. There is absolutely nothing in the patent claims which even hints at, much less "particularly point(s) out and distinctly claim(s)", that the patented invention is in any degree whatsoever dependent upon (1) the formation of a leak proof joint between sections of pipe, or (2) that such leak proof joint is made by the provision of male and female fittings, or (3) that the completed joint between adjacent ends of adjoining sections of the inner and outer pipes is in substantial radial alignment, or (4) that by the leak proof joints, so formed by male and female fittings, etc., each string of connected pipe is independently supported or maintained in connected relationship.

The Disclaimer Claims.– These attempt to define another and different and unpatented invention as existing in a combination, the first element of which is sectional pieces of the composite pipe defined in the patent claims, *and* the second element of which is (d) a particular means for joining the sections together in such manner to, and for the purpose of, producing joints between the sections, which joints (e) shed exterior moisture and are leak proof, *and* in which the completed joints between adjacent ends of adjoining sections are in substantial radial alignment; *also* (f) that thereby each string of connected pipe is independently supported and maintained in connected relationship, and further and independent of the thus claimed combination between the sections and the con-

necting means, these disclaimer claims specify a particular attribute of a particular form of insulating material not a part of the patent claims, i. e., (g) that the insulating material between the two pipes of the sections shall provide an intermediate filler having a plurality of air cells running longitudinally therethrough.

For the sake of emphasis, as well as clarity, we repeat that the disclaimer claims would embrace the following, *not called for or comprehended by the patent claims:–*

(1) that the composite pipe should be made in a plurality of sections;

(2) that adjacent ends of the inner and outer pipes of each section shall have a particular mechanical element for connecting sections together, to wit: male and female ends, etc.;

(3) that these connecting means shall be such that

  (a) a joint is provided between the sections which sheds any exterior moisture, and

  (b) that the completed joints are in substantial radial alignment;

(4) that the respective outer and inner tubes of the connected sections shall be independently supported and maintained in connected relationship;

(5) that the insulating material interposed between the two pipes shall be of such form and construction as to provide an intermediate filler having a plurality of air cells running longitudinally therethrough.

In *Carson v. American Smelting & Refining Co.*, 4 F. 2nd 463, 469, this Court said:–

> "A disclaimer may never be resorted to for the purpose of materially altering the character of an

> invention. It can only be used to surrender some 'separable matter, which can be exscinded without mutilating or changing what is left standing.' * * * In Cartridge Co. v. Cartridge Co., 112 U. S. 624, 642, 5 S. Ct. 475, 485 (28 L. Ed. 828), it was said: 'A disclaimer can be made only when something has been claimed of which the patentee was not the original or first inventor, and when it is intended to limit a claim in respect to the thing so not originally or first invented.' "

In limine, we wish to stress the point that the question as to the validity of this purported disclaimer does not turn upon whether in some sense its effect was to narrow the patent claims 1, 2 and 3. Obviously, a combination which is limited to having four elements is a narrower combination than one which requires only three of the principal elements of a machine. But this is not the function of a disclaimer. To disclaim a combination comprised only of the three elements, and to attempt by disclaimer to substitute therefor a combination consisting of these three elements with a fourth element, is to state a different combination, and *not to cut out or exscind a part of a claim* as authorized by the disclaimer statute. The mere fact that in a sense the effect of a purported disclaimer is to narrow the scope of the patent is not determinative of the legal question involved.–

> "While the effect of the disclaimer, if valid, was in one sense to narrow the claims, so as to cover the combinations originally appearing in claims 9 and 13 only when used in conjunction with a flywheel, it also operated to add the flywheel as a new element to each of the combinations described in the claims."

(*Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.,* 294 U. S. 477.)

It is well settled that the disclaimer statute (1) does not permit the addition of a new element to a combination previously claimed whereby the patent originally for one combination is transferred into a new and different one for the new combination, and (2) that upon the filing of disclaimers the original claims are withdrawn from the protection of the patent laws and the public is entitled to manufacture and use the device originally claimed as freely as though it had been abandoned. These are the exact rules applied by the Supreme Court in *Altoona Publix Theatres v. American Tri-Ergon Corp.,* 294 U. S. 477, 79 L. ed. 1005, and will be found at bot. of p. 490 of 294 U. S., and in 1st col. of p. 1014 of 79 L. ed., and 2nd par. of p. 492 of 294 U.S., and middle par. p. 1015 of 79 L. ed. A quotation from the opinion of the Court is reproduced in the Appendix hereto, p. 4. See, further, *American Lakes Paper Co. v. Nekoosa-Edwards Paper Co., et al.,* 83 F. 2nd 847 – C.C.A. 7 [Appendix, p. 7]; *Lowell v. Triplett,* 17 F. Supp. 996 [Appendix, p. 9]; *Fruehauf Trailer Co. v. Highway Trailer Co.,* 67 F. 2nd 558 – C.C.A. 6 [Appendix, p. 10]. See, also, *Fruehauf Trailer Co. v. Highway Trailer Co.,* 54 F. 2nd 691 (D.C. Mich.); *General Motors Corp. v. Rubsam Corp.,* 65 F. 2nd 217 (C.C.A. 6). *Corn Products Refining Co. v. Penick & Ford,* 63 F. 2nd 26 (C.C.A. 7) [Appendix, p. 12].

It is clear, therefore, that the Stadtfeld patent is invalid and the decree should be reversed upon this ground, with instructions to the District Court to dismiss the complaint; that the District Court's findings Nos. 7 to 16, inclusive, are contrary to the record evidence and proofs herein.

If Said Purported Disclaimer Can Be Sustained Under the Disclaimer Statute, Are Said Claims 1, 2 and 3, as So Re-Stated Thereby, Void for Want of Invention, and Anticipation?

We have heretofore pointed out that claims 3, 4 and 5 of the Stadtfeld application for patent as filed [III. 694] called for one length or piece of composite pipe provided with the connecting devices, (male and female fittings,) for forming the leak proof joints, and that additional claim 8 [III. 698] called for the combination of a plurality of pipe sections or lengths of composite pipe, each piece or length or section of such composite pipe provided with said connecting devices, (male and female fittings,) for forming the leak proof joints, for holding the respective inner and outer pipes in connected relationship and substantial radial alignment, etc., as referred to in the so-called disclaimer. We have also pointed out that these claims 3, 4, 5 and 8 were rejected as anticipated and as disclosing no invention over prior patents cited, and that Stadtfeld acquiesced in the correctness of such rejection and cancelled these claims as not patentable.

These facts are of importance here as they have two distinct bearings upon the issues of this case.

The *first* is that the statute does not authorize a disclaimer for the purpose of incorporating this rejected subject-matter into the patent claims. This is clear from a reading of the authorities heretofore cited. As said by Judge Tuttle in *Fruehauf Trailer Co. v. Highway Trailer Co.,* 54 F. 2nd 691 (D.C.), *supra,* at p. 695:– "* * * it is a basic principle of disclaimer law that that which is disclaimed shall have been claimed in one way or another." Thus it is necessary that what is disclaimed must

have been claimed in one way or another in the claims as granted in the patent.

The *second bearing* that these facts have is upon the issue of whether or not it involved invention to provide these old, well-known connecting means upon an old, well-known form of composite pipe. As distinctly stated by the Supreme Court in *Antoona Publix Theatres, Inc. v. American Tri-Ergon Corp., supra:–*

> "Upon the filing of the disclaimers, the original claims were withdrawn from the protection of the patent laws, and the public was entitled to manufacture and use the device originally claimed as freely as though it had been abandoned. To permit the abandoned claim to be revived, with the presumption of validity, because the patentee had made an improper use of the disclaimer, would be an inadmissible abuse of the patent law to the detriment of the public." (294 U. S. at p. 492; 79 L. ed. 1005, at p. 1015.)

The issue therefore is, – does the mere selection of an old, well-known form and construction of connecting means, (the male and female fittings,) at the respective ends of the lengths of composite pipe, amount to invention? This Court has answered this question in the negative in *Ray v. Bunting Iron Works,* 4 F. 2nd 214. [See Appendix, p. 14, for quotation.] It is clear that even if the disclaimer could, against the decision of the Supreme Court cited, be held valid and effective, the claims as modified by such disclaimer must be held invalid for want of invention.

In view of the rules of law and decision hereinbefore cited, it would seem supererogation to discuss the prior

patents anticipatory of the patent claims as granted. As we have pointed out, the filing of the disclaimer, as stated by the Supreme and other courts in the opinions cited, is a solemn declaration that Stadtfeld was not the inventor of the combination particularly pointed out and distinctly claimed in any of the patent claims. However, if the Court desires,—unnecessarily,—to consider such prior art and patents, for an original determination of this admitted fact, we call the Court's attention to the patents to Savage No. 500,779 of 1893 [Defts. Ex. 4-C – III. 719]; O'Toole No. 878,014 of 1908 [Defts. Ex. 4-E – III. 727]; Hammill No. 311,750 of 1885 [Defts. Ex. 4-A – III. 712]; Aldrich No. 340,691 of 1886 [Defts. Ex. 4-B – III. 715]; Harvey No. 534,473 of 1895 [Defts. Ex. 4-D – III. 723]; Meade No. 1,428,294 of 1922 [Defts. Ex. 4-F – III. 731]; and Welch No. 1,927,105 of Sept. 19, 1933 [Defts. Ex. 4-G – III. 736]. The application for this latter patent having been filed Oct. 8, 1932, its anticipatory effect is therefore the date of the application. (*Alexander Milburn Co. v. Davis-Bournonville Co.,* 270 U. S. 390, 70 L. ed. 651.) As none of these prior patents were cited by the Examiner of the Patent Office during the negotiations for the Stadtfeld patent, the *prima facie* presumption of validity is thus overcome (*Mettler v. Peabody Eng. Corp.,* 7 F. 2nd 56, 58 – C.C.A. 9).

The O'Toole patent [Defts. Ex. 4-E, III. 727] shows a pipe specially designed as a furnace pipe and to prevent the rapid escapement of heat [patent, p. 1, ll. 21-28, III. 727], comprising an inner and an outer pipe. These pipes are concentrically located relative to each other [*Id.* ll. 32-35]. A sheet of asbestos or other non-heat-conducting material is located between these concentric pipes

and the inner pipe is of such size relative to the outer pipe that it can be placed in proper position and proper contact with the asbestos sheet [*Id.* ll. 32-45]. Necessarily, the inner and outer concentric pipes, having asbestos interposed therebetween, form a tube operatively having the same function as the asbestos lining interposed between the inner and outer pipes of the Stadtfeld patent. Obviously, the outer and inner pipes are in slidable relation. O'Toole shows the composite pipe in sections [see Fig. 3, III. 726]. As we shall hereinafter point out when considering the question of unreasonable delay in filing disclaimer, this O'Toole patent was not one of the references before the Patent Office. It is our judgment that this patent was one of the impelling reasons why the disclaimer was filed. It was pleaded in the answer and it was made known to this defendant by defendant's attorneys. [See Defts. Ex. 12, III. 882.] This patent was also made known to and discussed with Stadtfeld by appellant's vice-president and general manager, El Roy Payne, at least a year before any application for patent was prepared or filed by Stadtfeld at the instigation of appellee [II. 610; Cf. Defts. Ex. 12, III. 882].

The Meade patent [Defts. Ex. 4-F, III. 730-31] shows a composite pipe. It is denominated a stove-pipe thimble, and when used as a thimble one use is to project through a floor or partition. The description is so full and definite that a reading thereof clearly discloses that it is made up of inner and outer pipes telescopically arranged with insulating material between the inner and outer pipes. Likewise this patent was not cited by the Patent Office against the Stadtfeld application.

The Savage patent 500,779 shows a chimney smokestack or flue-pipe comprising an inner and an outer pipe. The

inner pipe is described as preferably of copper, the outer pipe as of galvanized iron. Between these pipes there is a non-conductive packing of asbestos or mineral wool [see lines 57-61, III. 719]. Necessarily, the forcing of asbestos between the two pipes forms a tube operatively having the same function as the asbestos lining interposed between the outer and inner pipes in the Stadtfeld patent. Obviously, the outer and inner pipes are in slidable relation. The Savage patent shows the composite pipe made in sections. They must be slidable one with relation to the other to secure this relation of one with the other. A similar comparison of the showings of the other exhibits referred to will demonstrate their pertinency and the anticipation of the Stadtfeld claims as granted. However, inasmuch as this is an admitted fact,—a fact which appellee is estopped by the disclaimer from contesting,—we do not feel justified in extending this brief for further detailed consideration of these prior patents. These prior patents show means for connecting sections together, but do not show the specific male and female fitting construction originally claimed in original claims 3, 4, 5 and 8 of the Stadtfeld application which were rejected and cancelled, as hereinbefore pointed out. These claims 3, 4, 5 and 8 were rejected upon the patent to Bradbeer [Defts. Ex- 6-A, III. 778], as shown by the Patent Office actions [III. 701, 703, 705]. As Stadtfeld acquiesced in the correctness of the holding that there was no patentable novelty therein, and cancelled these claims, he is now estopped to contend otherwise. If, however, the Court desires to independently examine this anticipation, the construction and mechanical parts will be readily comprehended from the patent description and drawings.

It was old in the art at the time Stadtfeld claims to have made his alleged invention for pipes to be joined together by means of male and female fittings and to thereby provide leak proof joints. An example is the Bradbeer Patent 390,438 [Defts. Ex. 6-A, III. 778]. This is the prior patent cited by the Patent Office Examiner in the prosecution of the Stadtfeld application, and clearly shows in the drawing that the adjacent sections of the composite pipe shown therein were so joined by such means. The Meade Patent 1,428,294 [Defts. Ex. 4-F, III. 729] shows a stove-pipe thimble comprising two telescoping sections joined together by male and female fittings. The Line Patent 690,744 [Defts. Ex. 6-C, III. 787] shows the adjoining sections of the air-conducting tubes joined together by male and female joints. The same construction is also shown in Line Patent 696,059 [Defts. Ex. 6-D, III. 790]. Defts. Ex. 1 comprises depositions taken in Los Angeles on behalf of appellant. The photograph, Exhibit D thereto [III. 689] shows a vent pipe which was common construction in Los Angeles, California, for many years prior to the claimed date of the Stadtfeld invention. The numeral 4 on said photograph was placed thereon by appellee's counsel for the purpose of showing that two sections of the vent pipe were joined together by male and female joints [I. 153-54]. Furthermore, it was old, common practice to join two sections of vent pipe together by male and female joints in such a manner that any moisture condensing within the pipe would not run out through the joints but would run down inside the pipe. Defts. Ex. 24 [III. 903] is Bulletin No. 302 distributed by appellant early in 1932, concededly antedating Stadtfeld's invention as a printed publication. On p. 3 of said Bulletin [III. 905] the in-

structions are that in installing a new vent, "The female end of each section must look UP * * * This method of installing prevents any of the moisture condensing in the pipes from running out of the joints." It is thus seen that appellant prior to the Stadtfeld invention had published and disclosed to the public not only the necessity for, but the means of, joining together sections of pipe by male and female joints in such manner that any condensates would flow to the inside instead of the outside of the pipe. This is exactly what is shown in the drawings and described in the written specification of the Stadtfeld patent,—*although not claimed in the claims as granted,*—which appellee is attempting to recapture by reframing new and different claims by the purported disclaimer. Defts. Ex. 24 does not disclose or describe the manner in which the sections of the outer pipe are joined together. It would be obvious, however, from the disclosure how to cause moisture condensates to flow to the outside of the outer pipe, in the same manner as disclosed for the inner pipe.

With this common knowledge existent in the prior art, it clearly would not rise to invention to select the male and female joints, as described in the disclaimer, to join together the old, well known composite pipes shown in the Savage patent 500,779, the O'Toole Patent 878,014, or the Meade Patent 1,428,294. The knowledge and skill of the workman in the art is sufficient to enable him without creative genius to make such selection, and even if the claims could be adjudged to have been lawfully reframed and restated by the disclaimer, it is clear that they are void for anticipation and want of invention.

Not only does the record disclose, by the prior patents heretofore cited, that a composite pipe as defined in the

patent claims was old, but the depositions taken on behalf of appellant at Los Angeles [I. 86, *et seq.*] establish that it had long been the practice to install composite pipe for carrying flue gases, such pipe consisting of an inner pipe of metal, an outer pipe of metal, and a corrugated galvanized tin spacer therebetween. The space between the inner and outer pipe was air space with the exception of the area taken up by the spacers. Several installations prior to 1932 were established beyond doubt. A typical one is that established by the testimony of Ben Henry Baker, a plumber, at present manager for J. Hokom Plumbing Company of Los Angeles [I. 118]. Mr. Baker testified that he installed the vent pipe shown in Exhibit D to Exhibit 1 [III. 689] in 1923 [I. 121-23]. That he has continuously lived in said house and that the said installation has not been changed. The inner pipe of that installation is slidable with reference to the outer pipe [I. 127]. Reference to the photograph [III. 689] will clearly indicate that with the exception of the insulating material (old and well known in the art), all the elements of the patent claims are present. The insulating material would have the same purpose and effect if inserted between the outer and inner pipe of the Baker installation as the insulating material shown in the various prior art patents heretofore referred to and no invention would reside in substituting for the corrugated galvanized iron spacer a well-known insulating material such as asbestos, mineral wool, etc. This selection of the preferred form of elements from old prior art structures, including as it does the leak proof joints before discussed, clearly brings the case within the rule applied by this Court in *Ray v. Bunting Iron Works* (*supra*) and is further illustrated by the judgment of the Patent Office Examiner.

As said by the Patent Office Examiner in his official action in again rejecting claim 8:—

> "Claim 8 is again rejected on the reference to Bradbeer, as being fully met thereby. As the Examiner reads this reference and the claim, the Bradbeer reference shows applicant's exact coupling means, except for a reversal of parts. If the pipe of Bradbeer were reversed, that is, the bottom end of his pipe put at the top and the top end put at the bottom, the joints would be in the same relation as set forth in the claim. It is held the pipe of Bradbeer could be so reversed without the exercise of invention."
>
> [III. 705.],

which action of rejection was repeated by the Patent Office Examiner after considering the arguments on behalf of Stadtfeld [III. 708]. Appellee admits by the disclaimer that it was not novel invention to provide a composite pipe construction comprising (1) an outer tube, (2) one or more layers of insulating material located around the inside surface of the outer tube, and (3) an inner tube slidably located inside the insulating material. Appellee admitted (by Stadtfeld's admission and cancellation of claim 5) that there was no invention in providing a composite pipe having an inner tube which had a female fitting at one end and a male fitting at the other end which is normally located near the female fitting of the outer tube, and insulating material interposed between the tubes, and admitted that there was no invention in "an inclined or upright flue construction" comprising a plurality of composite pipe sections joined together, the said sections including an inner pipe and an outer pipe, the outer pipe having

a female fitting at its lower end and a male fitting at its upper end, and the inner pipe having a male fitting at its lower end and a female fitting at its upper end, so that the sections when joined together presented moisture-shedding joints wherein the lower end of the outer pipe of an upper section overlaps and is disposed outside the upper end of the outer piper of the next lower section, and the upper end of the inner pipe of the next lower section overlaps and is disposed outside the lower end of the inner pipe of the first mentioned upper section [rejected and cancelled claim 8, III. 698]. It is difficult to comprehend any substantial difference between this rejected and cancelled claim 8 and either claim 1, 2, or 3 of the patent, *as attempted to be modified and restated by the disclaimer to include the very features of this rejected claim 8.* However, it is clear that under the decisions of the Supreme Court, of which *Hailes v. Van Wormer,* 87 U. S. 353, 22 L. ed. 241, is an example, there would be no invention in providing the composite pipe defined in claims 1, 2 and 3 as granted in the patent, with the admittedly old well-known male-and-female-fittings non-leak-joint construction defined in rejected and cancelled claims 3, 4, 5 and 8. The particular joint-forming means are in no manner interdependent upon the particular construction of the composite pipe, to wit: the outer and inner pipes slidably arranged having asbestos interposed therebetween. Such an assembly in patent law would be an aggregation, and not a patentable invention. (Cf. *Hailes v. Van Wormer, supra; Keystone Driller v. Northwest E. Corp.,* 294 U. S. 42, 50, 79 L. ed. 747, 752; *Pow-*

ers-Kennedy Corp. v. Concrete M. & C. Co·, 282 U. S. 175, 186, 75 L. ed. 278, 286; *Grinnell Washing Mach. Co. v. E. E. Johnson Co.,* 247 U. S. 426, 62 L. ed. 1196.)

The effort of appellee by the purported disclaimer is to assert invention in selecting the particular connecting means shown by the Patent Office to be old and acquiesced in as old in the Patent Office proceedings, and to combine these with the old, well-known composite pipe comprising an inner and an outer pipe with asbestos therebetween. This selection obviously cannot amount to invention (*Ray v. Bunting Iron Works, supra*).

Is the Stadtfeld Patent Void Because Appellee Unreasonably Neglected and Delayed in Filing Disclaimer?

The beneficent remedial privilege afforded a patentee by the disclaimer statutes is expressly limited.– "But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer." *(R.S.U.S. 4922, 35 USCA, Sec. 71.)*

The patent in suit issued Sept. 3, 1935 [III. 637]. This suit was filed July 27, 1936 [I. 6]. Appellant's answer was filed June 15, 1937 [I. 42] and pleaded the Savage, O'Toole, Aldrich, Meade, Hammill, and Welch patents [I. 30-31]. Appellee neglected and delayed until Feb. 25, 1938, to file any disclaimer [III. 638],—ten days over seven months after such most formal notice of said prior patents and of their anticipation of the patent claims,—which anticipation was not questioned, but admitted by

appellee. This delay was unreasonable within the requirements of said statute (*Otis Elevator Co. v. Pacific Finance Corp.,* 68 F. 2nd 665, 670 – C.C.A. 9, in which the referred to delay "from the submissions of the exceptions to the District Judge" [68 F. 2nd, next to last par. p. 671] was from Oct. 15, 1930 to May 1, 1931,—six months and 13 days, a shorter time than the unexcused delay in the case at bar). In *Ensten v. Simon Ascher & Co.,* 282 U. S. 445, 452-3, 75 L. ed. 453, 457, the Supreme Court quotes with approval from *Robinson on Patents,* p. 284:–

> " 'The same principle which forbids a patentee to assert a right to more than he has actually invented compels him to disavow the right as soon as he discovers that it has been unjustly claimed. Unreasonable delay in disclaiming is thus tantamount to an original fraudulent claim, and through it the patentee loses the privilege of making the amendment by which alone his patent could be saved. The question of unreasonable delay is a question for the court, upon the facts as found either by its own investigation or the verdict of a jury. DELAY BEGINS WHENEVER THE PATENTEE BECOMES AWARE THAT HE HAS CLAIMED MORE THAN HE HAS INVENTED OR DESCRIBED. In cases where the excess is not apparent at once upon the inspection of the patent by the patentee, the allowance of his claim by the Patent Office raises such a presumption in its favor that he may rely on its validity until a court of competent jurisdiction decides that it is broader than his real invention." (*Emphasis ours.*)

and further says (at 282 U. S. 453, 75 L. ed. 457):–

> "Under this view, a patentee having procured allowance of an invalid claim may hold it in the face of the public for years (here nearly two years) with large possible advantage to himself and much injury to others. By the assertion of his apparent monopoly he may deter others from legitimate action and seriously prejudice the public. See Miller v. Bridgeport Brass Co., 104 U. S. 350, 355, 26 L. Ed. 783, 785."

As said by Judge Westenhaver in *Ensten v. Rich-Sampliner Co.,* 13 F. 2nd 132, 136:–

> "In Minerals Separation v. Butte, etc., Mining Co., 250 U. S. 336, 354, 39 S. Ct. 496, 63 L. Ed. 1019, a delay of 3 months and 17 days after final decision was excused, because the owners of the patent resided in a foreign country and war-time conditions then prevailing rendered communication slow and difficult. If foreign residence and war-time conditions must be invoked to explain a delay so brief, an unexplained delay of 2 years must certainly be held unreasonable."

The disclaimer statute affords its remedy only to an inventor or patentee who "through inadvertence, accident, or mistake, and without any willful default or intent to defraud or mislead the public," has claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not in fact the original and first inventor or discoverer. (*R. S. U. S. 4922* – Appendix, p. 1.] There was willful default on the part of Stadtfeld. After Dutton had abandoned

the joint venture with Stadtfeld of manufacturing and selling this pipe, Stadtfeld entered the employ of Payne Furnace & Supply Company. No application for patent was filed because that company had had an examination made and secured a report by its attorney, O'Connor, that the pipe was not novel and patentable [see Defts. Ex. 12, III. 882]. This report refers to the O'Toole and other patents. It was shown to Stadtfeld by Le Roy Payne and discussed by them more than a year prior to the application for the patent in suit [Payne, II. 610; Stadtfeld, II. 544]. Definite knowledge was thus brought home to Stadtfeld that a composite pipe comprising the combination of an inner and an outer pipe with insulating material therebetween was old. Stadtfeld and his subsequent assignee (appellee) were chargeable with this knowledge, and it was willful default and neglect to claim and to have procured the grant of the patented claims.

As we have heretofore pointed out, appellee did not, however, disclaim because the Stadtfeld patent claims were broader than his real invention, but because, as he now asserts by the disclaimer, Stadtfeld's only invention was an entirely different combination, a combination composed of sections of composite pipe, joined together by specific connecting means, which had the function, in addition to connecting the sections together, of providing leak proof joints, radial alignment, etc.

Clearly, appellee's unexplained and inexcusable delay inhibits it from the privilege of the disclaimer statute.

Conclusion.

Appellant submits:

(1) That the "transformation" of the claims of the patent, as attempted by the disclaimer, "is plainly not within the scope of the disclaimer statute"; that the attempted disclaimer is void; that "with the invalid disclaimer must fall the original claims as they stood before the disclaimer", and that the patent stands before the Court void (*Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp., supra* [see Appendix, bot. p. 5, top. p. 6].

(2) That the patent in suit is void because appellee unreasonably neglected and delayed in filing a proper disclaimer; that there has been unreasonable neglect in view of the direct knowledge imparted to Stadtfeld more than a year before the filing of the Stadtfeld application on behalf of appellee.

(3) That by reason of the rejection and cancellation of Stadtfeld's application claims 3, 4, 5 and 8 appellee is estopped to contend that it required invention to produce the leak proof joint dependent upon the male and female fittings.

(4) That the patent in suit is void because anticipated and for want of invention, for the reasons hereinbefore stated.

(5) That the decree or judgment of the District Court should be reversed with costs and with instructions to dismiss the appellee's complaint with costs to appellant.

Respectfully submitted,

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APPENDIX.

R. S. U. S. 4917 (35 USCA, Sec. 65).

"Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.

R. S. U. S. 4922 (35 USCA, Sec. 71).

"Whenever, through inadvertence, accident, or mistake, and without any willful default or intent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or

discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer."

R. S. U. S. 4916 (35 USCA, Sec. 64).

"Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee, or, in case of his death or of an assignment of the whole or any undivided part of the original patent, then to his executors, administrators, or assigns, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the amended patent.

The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. The specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specifications, shall have the same effect and operation in law on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the Commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid."

R. S. U. S. 4888 (35 USCA, Sec. 33).

"Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which

he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor."

R. S. U. S. 4899 (35 USCA, Sec. 48).

"Every person who purchases of the inventor or discoverer, or, with his knowledge and consent, constructs any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or who sells or uses one so constructed, shall have the right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor."

Altoona Publix Theatres, Inc., v. American Tri-Ergon Corp., 294 U. S. 477, 79 L. ed. 1005.

"While the effect of the disclaimer, if valid, was in one sense to narrow the claims, so as to cover the combinations originally appearing in Claims 9 and 13 only when used in conjunction with a flywheel, it also operated to add the flywheel as a new element to each of the combinations described in the claims. The disclaimer is authorized by Rev. Stat. Sec. 4917, which provides that when 'through inadvertence, accident, or mistake . . . a patentee has claimed more than that of which he was the . . . inventor . . . his patent shall be valid for all that part which is truly and justly his own,' provided that he or his

assigns 'make disclaimer of such parts of the thing patented as he shall not choose to claim . . . stating therein the extent of his interest in such patent.' While this statute affords a wide scope for relinquishment by the patentee of part of the patent mistakenly claimed, where the effect is to restrict or curtail the monopoly of the patent, it does not permit the addition of a new element to the combination previously claimed, whereby the patent originally for one combination is transformed into a new and different one for the new combination.

"If a change such as the present could validly be made, it could only be under the provisions of the reissue statute, Rev. Stat. Sec. 4916, which authorizes the alteration of the original invention in a reissued patent, upon surrender of the old patent, for its unexpired term. Upon the reissue 'the specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications are.' A patent amended by disclaimer thus speaks from the date of the original patent, while the re-issued patent, with respect to the amended claim, speaks from the date of re-issue. If respondent could thus, by disclaimer, add the flywheel to the arcuate flexing claim and to the optical claim, he would in effect secure a new patent operating retroactively in a manner not permitted by the re-issue statute and without subjecting the new claims to revision or restriction by the customary patent office procedure required in the case of an original or re-issued patent. Such transformation of a patent is plainly not within the scope of the disclaimer statute, and the attempted disclaimer as applied

to Claims 9 and 13 is void. Hailes v. Albany Stove Co., 123 U. S. 582, 587, 31 L. ed. 284, 286, 8 S. Ct. 262. See Union Metallic Cartridge Co. v. United States Cartridge Co., 112 U. S. 624, 642, 28 L. ed. 828, 833, 5 S. Ct. 475; Collins Co. v. Coes, 130 U. S. 56, 68, 32 L. ed. 858, 862, 5 S. Ct. 514. Compare Grant v. Walter, 148 U. S. 547, 553, 37 L. ed. 552, 556, 13 S. Ct. 699. It is unnecessary to consider whether the flywheel claim, if added to the original Claims 9 and 13, is such a part of the patentee's original conception as to entitle it to the benefit of the re-issue statute. See Miller v. Bridgeport Brass Co., 104 U. S. 350, 355, 26 L. ed. 783, 785; Hoffheins v. Russell, 107 U. S. 132, 141; Gage v. Herring, 107 U. S. 640, 645, 27 L. ed. 601, 603, 2 S. Ct. 819; Ives v. Sargent, 119 U. S. 652, 663, 30 L. ed. 544, 548, 7 S. Ct. 436; Corbin Cabinet Lock Co. v. Eagle Lock Co., 150 U. S. 38, 41-43, 37 L. ed. 989, 990, 991, 14 S. Ct. 28.

"With the invalid disclaimer must fall the original claims as they stood before the disclaimer. The disclaimer is a representation, as open as the patent itself, on which the public is entitled to rely, that the original claim is one which the patentee does not, in the language of the statute, 'choose to claim or hold by virtue of the patent.' Upon the filing of the disclaimers, the original claims were withdrawn from the protection of the patent laws, and the public was entitled to manufacture and use the device originally claimed as freely as though it had been abandoned. To permit the abandoned claim to be revived, with the presumption of validity, because the patentee had made an improper use of the disclaimer, would be an inadmissible abuse of the patent law to the detriment of the public."

(294 U. S. 489-492, 79 L. ed. 1013-15.)

American Lakes Paper Co. v. Nekoosa-Edwards Paper Co., et al., 83 F. 2nd 847—C. C. A. 7.

"It is further contended by appellant that the effect of the Cincinnati roll as an anticipation is overcome by two disclaimers filed by appellant as assignee of Seaborne. The first was filed on July 24, 1933, before the trial and after the depositions establishing that defense had been taken. The original specifications provided that the designs on the outermost cover, h^2, should be ground, formed or cut. None of the claims said anything about how the design should be imparted to the outer surface. In the Cincinnati roll the design was formed by molding. This disclaimer seeks to distinguish the patent from the Cincinnati roll by eliminating the word 'formed' from the specification and by converting the claimed invention from the one originally covered to one which consisted in applying a design to a marking surface by grinding or cutting as distinguished from forming. The District Court found that it had been common practice in the rubber roll art for many years, to produce surface designs either by grinding or cutting, or by molding, and that those methods had long been well recognized mechanical equivalents. The evidence fully supports this finding. The distinction sought to be raised by this disclaimer is not a sufficient basis for invention.

"The second disclaimer was filed after the District Court's decision upholding the Cincinnati defense. The Cincinnati roll was made up of a number of strips or sleeves vulcanized together at their edges, instead of being

made of a single continuous piece as called for in claim 8. It will be noted, as hereinbefore stated, that Seaborne had referred to a permissible modification of his alleged invention, in that instead of the outer or marking roll being a continuous sleeve, it might be a series of marking plates, illustrated by certain figures referred to in the second disclaimer. The purpose of this disclaimer was to eliminate these figures and all parts of the specification relating to them; to eliminate from the scope of each and all of the claims any marking roll whose engraved hard rubber cover was not continuous; and to limit the scope of each and all of the claims to a marking roll with a single one-piece outer hard rubber sleeve in which the design was engraved. It is further to be noted that the original patent stated that the designs should be 'ground, formed, or cut;' the first disclaimer eliminated the word 'formed;' and the second disclaimer eliminates the words 'ground' and 'cut' and inserts the word 'engraved,' which is nowhere found in the original patent.

"It is clear that the Cincinnati roll, although made up of several sections, constitutes a continuous outer sleeve or cover. It is urged by appellant that its outer surface without seams is better for 'all over' designs such as spider webs and the like, but nowhere in the patent is an 'all over' design mentioned. Even so, it would hardly amount to invention to eliminate a vulcanized joint.

"We are convinced that the disclaimers purport to change the character of the invention for which the patent was originally granted, and for that reason, among others, we think the claims are invalid. The filing of the disclaimers was an effort to avoid the clear anticipation of the Cincinnati roll, and it has resulted in a defeat of the

claims of the patent under the rulings in the following cases: Altoona Public Theatres, Inc., v. American Tri-Ergon Corporation, *supra;* Hailes v. Albany Stove Co., 123 U. S. 582, 8 S. Ct. 262, 31 L. Ed. 284; Fruehauf Trailer Co. v. Highway Trailer Co. (D. C.) 54 F. (2d) 691, affirmed (C. C. A.) 67 F. (2d) 558; General Motors Corporation v. Rubsam Corporation (C. C. A.), 65 F. (2d) 217; Corn Products Refining Co. v. Penick & Ford (C. C. A), 63 F. (2d) 26; Albany Steam Trap Co. v. Worthington (C. C. A.), 79 F. 966. The District Court's ruling was right in holding the claims invalid for anticipation and lack of invention." (p. 851.)

Lowell et al. v. Triplett et al., 17 F. Supp. 996.

"Thus it must be concluded that claim 1 discloses no new hum-eliminating means, and that, if section (c) relating merely to the method of effecting grid bias be eliminated, it is identical with the disclosures in the articles by Moye and Dr. P. C., and therefore would be void for anticipation. How, then, must we treat the effect of the inclusion of section (c)? As we have seen, it discloses something which is novel, but that novelty is not part of the claimed invention which is the elimination of hum. However, further elaboration of this distinction appears to be unnecessary, because it is certainly clear that section (c) renders the whole claim void because it is not merely new in the sense that it is an invention, but it is a new part of the claim, inserted for the first time by the disclaimer. That is to say, it cannot, as we have seen, be considered as part of a plurality of means 'for eliminating the hum of said alternating current in said appara-

tus,' because it is not a hum-eliminating means, but a means for effecting grid bias. We have seen that the disclaimer rule prohibits the introduction, without invalidating the original claim, of anything not embraced in the original claim. Claim 2, of which claim 1 is typical, is likewise invalid." (p. 1009.)

Fruehauf Trailer Co. v. Highway Trailer Co., 67 F. 2nd 558—C. C. A. 6.

"We quite agree with the views expressed by the learned trial judge upon the subject of the disclaimers. The enactment of Rev. St. Sec. 4917 (35 USCA Sec. 65), was never intended to permit the revamping and rephrasing of claims to the end that they might cover structures upon which they did not before read, or to the end that, by the addition of a new element in combination, the disclaimer might validate a claim which would otherwise be invalid under the prior art. This is not limiting the combination already claimed; it is in effect claiming a new and a different combination. General Motors Corp. v. Rubsam Corp., 65 F. (2d) 217 (C. C. A. 6); Linville v. Milberger, 34 F. (2d) 386, 390 (C. C. A. 10); Albany Steam Trap Co. v. Worthington, 79 F. 966, 969 (C. C. A. 2). The function of a disclaimer is well stated in the leading case of Hailes v. Albany Stove Co., 123 U. S. 582, 587, 8 S. Ct. 262, 265, 31 L. Ed. 284. It must cover 'a separate claim in a patent, or some other distinct and separable matter, which can be exscinded without mutilating or changing what is left standing.' It cannot be used to change the character of the invention, or, in effect, to make for the patentee a new patent. This is fundamental.

As to the distinction between disclaimer and reissue, we approve and adopt the position of the Circuit Court of Appeals for the Second Circuit that such 'distinction is between disclaiming a part separated in the patent itself as opposed to something comprehended in its general language.' Grasselli Chemical Co. v. National Aniline & Chemical Co., 26 F. (2d) 305, 310 (C. C. A. 2). Compare also Corn Products Ref. Co. v. Penick & Ford, 63 F. (2d) 26, 30 (C. C. A. 7); Strause Gas Iron Co. v. William M. Crane Co., 235 F. 126, 130 (C. C. A. 2); Hudson Motor Car Co. v. American Plug Co., 41 F. (2d) 672 (C. C. A. 6).

"Tested by these standards, both disclaimers are invalid. That to the first patent disclaims matter which is not separated in the patent itself, and which in fact is not expressly referred to in the patent, and its obvious purpose is to add to the claim description the structural feature that the horizontal level of the platform upon the tractor shall be slightly higher than the plane of the lower surfaces of the 'skid-like member' when the trailer is uncoupled, whereby the supports which hold up the forward end of the trailer body, when so uncoupled, are raised slightly from the ground by the coupling operation itself, and may be lowered, before uncoupling, to receive the weight of the trailer body when the uncoupling operation is completed. There is nothing in the claims or in the specification to show that Borst did not have in mind an organization of elements analogous to that found in the French patent to Jagenberg, No. 355,154, June 10, 1905, where the planes of the fifth wheel coupling elements upon the tractor and the trailer are held at substantially the same height both when coupled and when uncoupled." (pp. 559-560.)

Corn Products Refining Co. v. Penick & Ford, Ltd., Inc., 63 F. 2nd 26—C. C. A. 7.

"Passing the questions of delay in filing and of the effect of the disclaimer as an admission of the invalidity of the original claims, we are of the opinion that the document here in question is not a valid disclaimer. The statute limits the amendment of claims through disclaimer to that which 'is a material and substantial part of a thing patented and definitely distinguishable from the parts claimed without right.' The Supreme Court, in Hailes v. Albany Stove Co., 123 U. S. 582, 587, 8 S. Ct. 262, 265, 31 L. Ed. 284, construed the statute: 'A disclaimer is usually and properly employed for the surrender of a separate claim in a patent, or some other distinct and separable matter, which can be exscinded without mutilating or changing what is left standing. Perhaps it may be used to limit a claim to a particular class of objects, or even to change the form of a claim which is too broad in its terms; but certainly it cannot be used to change the character of the invention. And if it requires an amended specification or supplemental description to make an altered claim intelligible or relevant, while it may possibly present a case for a surrender, and reissue, it is clearly not adapted to a disclaimer. A man cannot, by merely filing a paper drawn up by his solicitor, make to himself a new patent, or one for a different invention from that which he has described in his specification.'

**Before a part of a patent is disclaimed it must first be claimed* and it must be definitely distinguishable from the parts which the patentee is entitled to retain. There is a clear distinction between disclaiming a part separated in the patent itself as opposed to something comprehended

in the general language. Grasselli Chemical Co. v. National Aniline & Chemical Co., Inc. (C. C. A.), 26 F. (2d) 305; Strause Gas Iron Co. v. William M. Crane Co. (C. C. A.), 235 F. 126. (p. 30.)

* * * * * * * * *

"The extent to which the device of altering claims by disclaimer is carried in this case will be seen when we undertake to rewrite the claims by interpolating limitations in the parts which must remain if the claims are to survive. Claim 1 so rewritten is as follows:

" '1. Improved method of manufacturing starch *from corn, in a system wherein the solubles formerly permitted to run to waste and the water separated from insolubles are recovered* which comprises subjecting the starch bearing material in water to separating operations for removing starch therefrom, *wherein starch and gluten are washed from bran in a sieve system which includes sieves having minute openings and wherein starch, gluten and water are separated from each other at a stage following the bran washing operation and wherein the separated starch is washed and wash water and solubles therefrom are included in the recovery, steeping the corn in a portion of the water which has been separated from the starch and gluten subsequent to a tabling operation, withdrawing the steep water and recovering the solubles therein,* sterilizing *another portion of* the water *separated from the starch and gluten,* after use in these operations, using the same in similar operations on subsequently treated starch bearing material *in connection with the necessary make-up water in effecting separations preceding the starch tabling operation, washing the starch after separation thereof and re-using the wash water as make-up*

water.' (The portions in italics represent the additions through the disclaimer—matters which it is asserted were left out of the claim by inadvertence, accident or mistake.) If an attempt is made to rewrite claim 18 to conform to the disclaimer, it will be found that sentences cannot be constructed to combine the original claim and the disclaimer.

"The statute (R. S. Sec. 4888, 35 USCA Sec. 33) requires that a patentee shall particularly point out and particularly claim the part, improvement, or combination which he claims as his invention. The claim prescribed by the statute is for the very purpose of making the patentee define precisely what his invention is. The disclaimers here make the claims so indefinite, obscure, and ambiguous that they do not stand the statutory test. To sustain the disclaimer in this case will require us to go farther than any court has ever gone and to sanction a method of indirect amendment which nullifies the purpose of the statute. **Moreover, the disclaimer does not strike anything from the specification and the claims as modified by the disclaimer retain sterilization as a distinct step in the process.* In that respect the claims as modified by the dilsclaimer do not differ from the original claims." (p. 31.) (*) (This portion of emphasis ours.)

Ray et al. v. Bunting Iron Works, 4 F. 2nd 214—C. C. A. 9.

" 'It is said that appellee's carrier is not anticipated by any single patent; but it is not necessary to show complete anticipation in a single patent. The selection and putting together of the most desirable parts of different machines in the same or kindred art, making a new ma-

chine, but in which each part operates in the same way as it operated before and effects the same result, cannot be invention; such combinations are in the nature of things the evolutions of the mechanic's aptitude rather than the creations of the inventor's faculty.' Huebner-Toledo Breweries Co. v. Mathews Gravity Carrier Co., 253 F. 435, 447, 165 C. C. A. 177, 189.

"In Elite Mfg. Co. v. Ashland Mfg. Co., 235 F. 893, 895, 149 C. C. A. 205, 207, the same court said:

" 'The various elements shown in plaintiff's patent and mentioned in its respective claims are all found in the prior art, performing respectively the same function in the same way and producing the same result as in plaintiff's device. We are not unmindful that to combine old parts in such manner as to produce a new result by their harmonious co-operation may be patentable; but where the combination is not only of old parts, but obtains old results, without the addition of any new and distinct function, it is not patentable. There is no invention in merely selecting and assembling, as Burkholder did, the most desirable parts of different mechanisms in the same art, where each operates in the same way in the new device as it did in the old, and effects the same results.'

"To the same effect, see Le Roy v. Nicholas Power Co. (D. C.), 244 F. 955; Specialty Manfg. Co. v. Fenton Manfg. Co., 174 U. S. 492, 19 S. Ct. 641, 43 L. Ed. 1058; Burt v. Evory, 133 U. S. 349, 10 S. Ct. 394, 33 L. Ed. 647."